



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/548,201 04/13/00 VOTICKY

M 044839.0048

EXAMINER

WM02/0718

AKIN GUMP STRAUSS HAUER & FELD
1900 FROST BANK PLAZA
816 CONGRESS AVENUE
AUSTIN TX 78701

ESCALANTE, D

ART UNIT

PAPER NUMBER

2645

DATE MAILED:

07/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/548,201

Applicant(s)

VOTICKY ET AL.

Examiner

Ovidio Escalante

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) 5-52, 54-63, 72 and 73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 53, 64-71 and 74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-74 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- I.** Species I, claims 5-27 and 72, drawn to the information message being an e-mail message.
 - i.** Sub-species I-1 to Species I-22. Claims 5-26, drawn to plural species for personalized identifiers for identifying senders of e-mail messages. For example, species I-1 uses the sender's e-mail address and species I-22 uses the sender's thumbprint. Claims 5-26 consists of a total of 22 sub-species which ranges from Species I-1 for claim 5 to Species I-22 for claim 26.
- II.** Species II, claims 28-45 and 73, drawn to the information message being a facsimile message.
 - ii.** Species II-1 to Species II-16. Claims 28-43, drawn to plural species for personalized identifiers for identifying senders of facsimile messages. For example, species II-1 uses the sender's caller-ID number and species II-16 uses the sender's thumbprint. Claims 28-43 consists of a total of 16 sub-species which range from Species II-1 for claim 28 to Species II-16 for claim 43.
- III.** Species III, claims 46-65 and 74, drawn to the information message being a voice mail message.
 - iii.** Sub-Species III-1 to Species III-18. Claims 46-63, drawn to plural species for personalized identifiers for identifying senders of Voice Mail messages. For

example species III-1 uses the sender's Caller-ID number and Species III-18 uses the sender's thumbprint. Claims 46-63 consists of a total of 18 sub-species which range from Species III-1 for claim 46 to Species III-18 for claim 63.

Applicant is required under 35 U.S.C. 121 to elect a single species from species I-III and further elect a single sub-species (I-1 to I-22, II-1 to I-16, III-1 to III-18) for identifying the message sender corresponding to the elected species from species I-III. Therefore, the Examiner will examine two elected species (a single specie and a single sub-specie) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. For example, if Applicants elect species I they must also elect a sub-species from the group of species I-1 to species I-22. Currently, Claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

Art Unit: 2645

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. Independent and Dependent claims 2-4,66-71 are not subject to a restriction so they would be prosecuted along with the election of the species. Also claims 27, 44, 45, 64, 65 which fall into the Species category would be prosecuted if their corresponding Species is elected e.g., if Applicants elect Species III, for prosecution of voice mail, and further elects sub-Species III-1 for prosecution of the Caller-ID number for identification, claims 64 and 65 would also be searched since they do not fall under the personalized identifier limitation.

3. During a telephone conversation with Richard Knight on June 13, 2001 a provisional election was made without traverse to prosecute the invention of Species III and sub-Species III claims 74, 53,64 and 65. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-52,54-63,72 and 73 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The Examiner will examine and search claims 1-4,66-71,74,53,64 and 65.

Specification

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Information Disclosure Statement

7. The information disclosure statement submitted on March 30, 2001 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly the information disclosure statement is being considered by the examiner.

Drawings

8. The drawings filed April 13, 2000 have been objected to by the Draftsperson. Please see the attachment.

Claim Objections

9. Claim 4 is objected to because of the following informalities: The Examiner would like to remind Applicants that claim 4 should be amended to depend upon claim 1. The Examiner contacted Richard Knight and it was agreed that there was a typographical error in the amendment filed on May 25, 2001. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 68-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On line 6 of claim 68, it is not known what "other" refers to. Claim 69 is rejected because it depends on claim 68.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-3 and 68-71 rejected under 35 U.S.C. 102(b) as being anticipated by Scannell et al. US Patent 5,377,354.

As per claim 1:

Scannell teaches of a method and apparatus for prioritizing a plurality of incoming messages.

Scannell further teaches a method for an electronic communication message system to prioritize an information message (email message) (col. 2, lines 36-37, 49-62) comprising:

determining a personalized identifier to the message, (col. 5, lines 32,40,42,46,54,57 – the message may be identified by the sender field);

locating the personalized identifier in a database, (col. 7, lines 38-42), (The comparator 52 locates the sender identifier in the database that matches the received sender message);

assigning from the database a priority code (1 – highest priority through 5 – lower priority) corresponding the personalized identifier, (col. 6, lines 65-68); and

prioritizing the message according to the priority code, (col. 6, lines 65-68, col. 9, lines 23-30). The message is given a priority code depending on the rules that was predefined by the user.

As per claim 2:

Scannell teaches of wherein the priority code (col. 6, lines 65-68) is maintained in the database and corresponds to the personalized identifier in the database (col. 9, lines 23-30), and further comprising depositing the message in a virtual mailbox corresponding to the priority code, (col. 8, lines 14-19).

As per claim 3:

Scannell teaches of wherein the database, the personalized identifiers, the priority codes, and the correlation between the personalized identifiers and the priority codes are initially defined by a user and subsequently changeable by said user, (col. 6, lines 9-17). The user can set up rules that are used to sort or prioritize the messages.

As per claim 68:

Scannell teaches of a system for prioritizing a received information message, (lines 1-2 of the abstract), the system including a database (Rules Store, figs 1 and 2) maintaining known personalized identifiers and priority codes corresponding to known personalized identifiers (col. 6, lines 18-22, fig. 2; The personalized identifiers represent the identity of the senders and the associated priority fields 45 is used for assignment of a priority code, col. 6, lines 65-68), said system comprising:

a computing device (rules test unit -abstract) for determining a first personalized identifier associated with a received information message, (col. 5, line 65-col. 6, line 3);

Art Unit: 2645

a location device (comparator 52) for matching the first personalized identifier with an identifier in the database, (col. 7, lines 38-45);

a priority assignment device (priority assignment unit 45) for assigning a priority code to the received information message corresponding to any matched first personalized identifier, (col. 9, lines 23-30); and

a prioritizer to prioritize the message according to the priority code, (col. 9, lines 23-30, col. 6 lines 65-68).

As per claim 69:

Scannell teaches of a mailbox corresponding to the priority code, (col. 8, lines 14-19);
and

a system for depositing the message in the mailbox, (lines 15-19 of the abstract).

As per claim 70:

Scannell teaches of a computer-readable medium of instructions and data comprising:

a received message, (lines 4-5 of the abstract; col. 3, lines 37-39);

a personalized identifier corresponding to the received message, (block 26 (sender) of message 25, fig. 2);

computer instructions for receiving the message and the personalized identifier, (col. 3, lines 39-49);

a database (Rules Store 12, figs 1 and 2) containing known personalized identifiers, each having corresponding priority codes, (col. 6, lines 18-22);

computer instructions for locating the personalized identifier to the database to determine whether the personalized identifier is a known personalized identifier with an assigned priority code indicated in the database, (col. 7, lines 38-45);

a priority code corresponding to the message, (col. 6, lines 65-68, col. 9, lines 23-30);

computer instructions for assigning the priority code to the message, (col. 9, lines 23-30);

and

computer instructions for prioritizing or otherwise acting upon the message according to the priority code, (col. 6, lines 65-68, abstract).

As per claim 71:

Scannell teaches of the computer readable medium further comprising of a mailbox corresponding to the priority code, (col. 8, lines 14-19); and

computer instruction for depositing the message in the mailbox, (abstract, lines 14-19).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 2645

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claim 74 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Rochkind EP 0825752 A2.

As per claim 74:

While Scannell teaches of the information message being an e-mail message, Scannell does not specifically teach of the information message being a voice mail message.

Rochkind teaches of a system which prioritizes and sorts email messages, voice mail messages and multimedia messages, (page 54, lines 54-56). The system prioritizes incoming voice mail messages based on personalized rules set by the user such as using an address extension. The sender of a message will indicate an extension which will be used by the receiver's system to determine what priority the message should receive, (page 5, table 2). The message is then stored in the mailbox according to the priority code.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by prioritizing voice mail messages as

Art Unit: 2645

taught by Rochkind so that a user can prioritize all of the incoming voice, email and multimedia messages and can determine what messages are important without having to read or listen to all of the messages.

18. Claims 4 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Lim et al. US Patent 5,883,942, (hereinafter Lim).

As per claims 4 and 66:

Scannell, as applied to claim 1, does not specifically teach of providing a personalized response to the sender.

Lim teaches of a system which sends personalized responses to the caller depending on their caller identification, (lines 1-5 of the abstract, fig. 2A). Lim further teaches of wherein the elements of the method are performed by an automated system consisting of a voice-type message storage device, (col. 4, lines 28-29, the voice recorder records the message and the data storage stores the received message).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by having the system provide a personalized response to the sender based on the sender identification as taught by Lim so that the sender, if they are important to the message receiver, can receive a personalized message that indicates for example, that they can leave a message which will be given high priority; or if the identification can determine that the sender is not important then the system can play a different message and/or reject the sender's message.

19. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Katz US Patent 5,646,839.

As per claim 67:

Scannell as applied above, does not specifically teach of the identifier being a biometric signature technology that is associated with the sender and the message.

Katz teaches of wherein the personalized identifier is a biometric signature technology that is associated with the sender and the message, (col. 2, lines 60-67). The person is recognized before they can leave a voice message.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by using the biometric signature technology to identify the sender so that the user can be identified before the message arrives at the destination.

20. Claims 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Rochkind and further in view of Lim.

As per claims 64 and 65:

While Scannell and Rochkind as applied above teaches of wherein the information message is a voice mail message, they do not specifically teach of providing a personalized greeting or response.

Lim teaches of providing a personalized greeting or response to the sender based on the personalized identifier and the priority code, (lines 1-5 of the abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell and Rochkind by having the system provide a personalized response to the sender based on the sender identification as taught by Lim so that the sender, if they are important to the message receiver, can receive a personalized

message that indicates for example, that they can leave a message which will be given high priority; or if the identification can determine that the sender is not important then the system can play a different message and/or reject the sender's message.

21. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Rochkind and further in view of Katz.

As per claim 53:

While Scannell in view of Rochkind teaches of the information message being a voicemail message as applied to claim 74, Scannell and Rochkind failed to teach of the personalized identifier is derived from the voiceprint of an audio element associated with the voicemail message.

Katz teaches that using voice prints to identify a person is well known in the art, (col. 2, lines 60-67, col. 7, lines 44-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by using the biometric signature technology to identify the sender as taught by Katz so that the user can be identified before the message arrives at the destination.

Conclusion

22. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA, Sixth Floor (Receptionist).

23. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262.
The examiner can normally be reached on Monday to Friday from 6:30 AM to 5:00 PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group
is (703) 872-9314.

Communications via Internet e-mail regarding this application, other than those under 35
U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO
employees do not engage in Internet communications where there exists a possibility that
sensitive information could be identified or exchanged unless the record includes a properly
signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Ovidio Escalante
Examiner
Group 2645
July 16, 2001

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

